

Applicant : Ann Marie Schmidt, et al.
Serial No.: 10/666,513
Filed : September 19, 2003
Page 4

REMARKS

Claims 1, 2, 4, 15, 17-19 and 23 are pending in the subject application and claims 4, 17-19 and 23 are withdrawn from consideration. Claims 1, 4, 17-19 and 23 have been cancelled. Claims 2 and 15 have been amended. Support for the amendment to claims 2 and 15 can be found in the specification at, *inter alia*, page 36, line 4. Applicants maintain that the amendments to claims 2 and 15 do not raise any issue of new matter. Accordingly, claims 2 and 15 will be pending in the subject application upon entry of this Amendment.

Sequence Rules

The Examiner stated that sequences contained in the description of Figure 5 and Table 1 on page 36 must be referred to by SEQ ID Nos.

In response, applicants have amended the specification to reflect the SEQ ID Nos. as required by the Examiner.

Rejection under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 1 and 15 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner asserted that the disclosure in the specification does not provide a definition of what is encompassed by the

Applicant : Ann Marie Schmidt, et al.
Serial No.: 10/666,513
Filed : September 19, 2003
Page 5

term "EN-RAGE" peptide.

In response to the rejection of claim 1, applicants point out that this claim has been cancelled, rendering the rejection thereof moot.

In response to the Examiner's rejection of claim 15, applicants respectfully traverse. Applicants point out that amended claim 15 does define EN-RAGE peptide as having "the N-terminal amino acid sequence shown in SEQ ID NO:2."

In view of the above remarks, applicants maintain that claim 15 satisfies the requirements of 35 U.S.C. §112, first paragraph.

Rejection under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 1, 2 and 15 under 35 U.S.C. §112, second paragraph, as allegedly indefinite. Specifically, the Examiner asserted that the term "EN-RAGE" is indefinite because it only describes a protein or nucleic acid of interest by an arbitrary name.

In response to the Examiner's rejection of claim 1, but without conceding the correctness thereof, applicants point out that this claim has been canceled, thereby rendering the rejection thereof moot.

In response to the Examiner's rejection of claims 2 and 15, applicants respectfully traverse. Applicants point out that amended claims 2 and 15 do define EN-RAGE peptide as having

Applicant : Ann Marie Schmidt, et al.
Serial No.: 10/666,513
Filed : September 19, 2003
Page 6

"the N-terminal amino acid sequence shown in SEQ ID NO:2."

Further, the Examiner asserted that claim 2 is indefinite for incorporating by reference Table 1.

In response to the Examiner's rejection of claims 2, applicants respectfully traverse. Applicants point out that amended claim 2 does not incorporate by reference Table 1 but instead defines EN-RAGE peptide as having "the N-terminal amino acid sequence shown in SEQ ID NO:2."

In view of the above remarks, applicants maintain that claims 2 and 15 satisfy the requirements of 35 U.S.C. §112, second paragraph.

Rejections Under 35 U.S.C. §102(b) and §102(e)

The Examiner rejected claims 1, 2 and 15 under 35 U.S.C. §102(b) as allegedly anticipated by European Patent Application No. EP 0 731 166 A2 ("Hitomi 1") and under §102(e) as allegedly anticipated by U.S. Patent 5,976,832 ("Hitomi 2"). Specifically, the Examiner stated that Hitomi 1 and Hitomi 2 teach the amino acid sequence of EN-RAGE peptide disclosed in Table 1 which corresponds to SEQ ID NO:2.

In response to the Examiner's rejection of claim 1, but without conceding the correctness thereof, applicants point out that this claim has been canceled, thereby rendering the rejection thereof moot.

In response to the Examiner's rejection of claims 2 and 15,

Applicant : Ann Marie Schmidt, et al.
Serial No.: 10/666,513
Filed : September 19, 2003
Page 7

applicants respectfully traverse and maintain that Hitomi 1 and Hitomi 2 do not anticipate the presently claimed invention. Specifically, applicants maintain that the amino acid sequence described by Hitomi 1 and Hitomi 2 is not the amino acid sequence of SEQ ID NO:2, and thus, these references fail to teach all the elements of the rejected claims.

In view of the above remarks, applicants maintain that claims 2 and 15 satisfy the requirements of 35 U.S.C. §102(b) and §102(e).

Double Patenting

The Examiner provisionally rejected claims 1, 2 and 15 under 35 U.S.C. §101 as allegedly claiming the same subject matter as claims 1, 2 and 15 of U.S. Serial No. 10/665,867. In response, applicants will address this rejection regarding pending claims 2 and 15 once the rejection is made non-provisional.

Summary

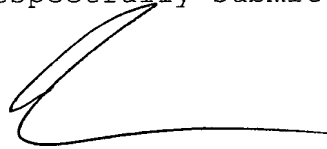
For the reasons set forth hereinabove, applicants respectfully request that pending claims 2 and 15 of this application be allowed, and that the application proceed to issuance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

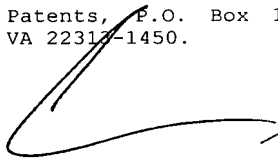
Applicant : Ann Marie Schmidt, et al.
Serial No.: 10/666,513
Filed : September 19, 2003
Page 8

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22312-1450.


11/18/04

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